

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** RAHAM BROD, BRIAN DAVIES, and TUNCEL IBRAHIM

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Appeal No. 1998-1216  
Application No. 08/356,194

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BRIEF

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Before TIMM, DELMENDO, and PAWLIKOWSKI, **Administrative Patent Judges**.

PAWLIKOWSKI, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1, 4-8, 10-12, and 16-26, which are all of the claims pending in this application. Claims 3, 9, and 27 were cancelled in the Amendment of Paper No. 5. Claims 2, 13, 14, and 15 were cancelled in the Amendment After Final Rejection of Paper No. 9. No claims have been allowed.

The subject matter on appeal is illustrated in claim 1, which reads as follows:

1. A fuel oil composition comprising a fuel oil and an additive composition comprising:

(a) an oil soluble ethylene copolymer having, in addition to units derived from ethylene, units of the formula



and units of the formula



the total molar proportion of units of the formulae I and II in the copolymer being less than 10%, wherein each R independently represents H or CH<sub>3</sub>, and each R<sup>1</sup> and R<sup>2</sup> independently represents a group of the formula COOR<sup>3</sup> or OOCR<sup>3</sup>, wherein each R<sup>3</sup> independently represents alkyl or alkenyl having 4 to 10 carbon atoms provided that the units of the formula I are different from the units of the formula II or

(b) comprising

- (i) an oil-soluble ethylene copolymer having, in addition to units derived from ethylene, less than 10 molar per cent of units of the formula



and (ii) an oil-soluble ethylene copolymer having, in addition to units derived from ethylene, less than 10 molar per cent of units of the formula



wherein R, R<sup>1</sup>, and R<sup>2</sup> have the meaning given above, provided that R<sup>3</sup> in COOR<sup>3</sup> represents alkyl or alkenyl having 4 to 10 carbon atoms, and provided that copolymer (i) differs from copolymer (ii) by at least 2000 in number average molecular weights.

The references relied upon by the examiner are as follows:

Toyoshima et al. (Toyoshima)	4,404,000	Sep. 13, 1983
Feldman	4,211,534	Jul. 8, 1980
Ilnyckyj et al. (Ilnyckyj)	3,961,916	June 8, 1976

Claims 1, 4-8, 10-12, and 16-26 stand rejected under 35 U.S.C. § 103 over Toyoshima in view of Ilnyckyj and further in view of Feldman.

### **OPINION**

For the reasons set forth below, we reverse the above-noted rejection.

The examiner's position is that it would have been obvious to one of ordinary skill in the art to have substituted the copolymer (A) of Toyoshima with the butylacrylate disclosed in Ilnyckyj, in view of the disclosure found in column 5, lines 6-8 of Ilnyckyj. (answer, pages 4-5).

Appellants argue that there is no teaching in Ilnyckyj or Toyoshima to suggest to one skilled in the art to substitute the materials of Ilnyckyj for the copolymer (A) of Toyoshima. Appellants argue that the particular copolymer (A) of Toyoshima must have an alkoxyalkyl group, and that the examiner's proposed substitution contradicts this aspect of Toyoshima's invention. (brief, page 4).

We note that the initial burden of presenting a prima facie case of unpatentability on any ground rests with the examiner. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We also note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990).

Here, we find the examiner has not convincingly explained why one skilled in the art would have been motivated to substitute the copolymer (A) of Toyoshima with the butylacrylate disclosed in Ilnyckyj. It appears that the examiner believes that because the butylacrylate is grouped with a C<sub>13</sub>oxoalkylmethacrylate at column 5, lines 6-8 of Ilnyckyj, these compounds are equivalent and therefore each would achieve the same results. (answer, pages 4-5). However, this disclosure of Ilnyckyj does not teach that the butylacrylate is equivalent to the particular copolymer (A) of Toyoshima, especially in the context of Toyoshima (i.e., combining with copolymer (B)). Furthermore, we agree with appellants' statement that the copolymer (A) of Toyoshima requires an alkoxyalkyl group, and therefore, there is no motivation to replace it with a non-alkoxyalkyl group type compound, as proposed by the examiner. (brief, page 4).

The examiner discusses Table 4 of Toyoshima. (answer, page 5). We find that Table 4 establishes that examples 1-7 achieve good results with respect to pour point values and cold filter plugging point values. These examples involve the use of Toyoshima's particular copolymer (A) with copolymer (B), wherein the copolymer (A) requires an alkoxyalkyl group. Examples 1-7 achieves better cold filter plugging point values than all of the other Comparative Examples listed in Table 4. This shows that the

combination of copolymer (A), having an alkoxyalkyl group, with copolymer (B) achieves improved results. These results refute that examiner's interpretation of Table 4.

In view of the above, we find that the examiner has not met her burden of establishing a prima facie case, and we reverse. We need not discuss the reference of Feldman, as this reference does not cure the above-mentioned deficiencies found in Toyoshima and Ilnyckyj.

#### **SUMMARY**

The rejection of claims 1, 4-8, 10-12, and 16-26 under 35 U.S.C. § 103 over Toyoshima in view of Ilnyckyj, and further in view of Feldman, is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

#### **REVERSED**

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CATHERINE TIMM	)
Administrative Patent Judge	)
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	) BOARD OF
	) PATENT
ROMULO DELMENDO	) APPEALS
Administrative Patent Judge	) AND
	) INTERFERENCES
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	)
BEVERLY PAWLIKOWSKI	)
Administrative Patent Judge	)

Appeal No. 99-1216  
S.N. 08/356,194

Paul D. Greeley, Esq.  
Ohlandt, Greeley, Ruggiero & Perle  
One Landmark Square, Suite 903  
Stanford, Connecticut 06901